# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/584,045 | 05/30/2000 | Andrew Hausman | 3524/14 | 9896 |

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| EXAMINER |
|---|
| SNAPP, SANDRA S |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3624 | |

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/584,045 | HAUSMAN, ANDREW |
| | Examiner | Art Unit |
| | Sandra Snapp | 3624 |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on _26 April 2004_.

2a)☒ This action is **FINAL**.      2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is

closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) _1-40_ is/are pending in the application.

    4a) Of the above claim(s) _1-14,18,21-33 and 38-40_ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _15-17, 19-20 and 34-37_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _26 April 2004_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _4-1-4 and 4-26-4_.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

### *Response to Amendment*

This Office Action is in response to the Amendments filed on 4-1-4 and 4-26-04. The Amendment to the specification filed 4-1-4 has been disregarded as per the Applicant's request in the Amendment filed 4-26-04, however the amendments to the remaining parts of the application have been considered. Currently, claims 15, 16, 17, 19, 20 and 34-37 are pending in the application. Claims 1-14, 18, 21-33 and 38-40 have been cancelled.

### *Information Disclosure Statement*

The information disclosure statements (IDSs) submitted on 4-1-4 and 4-26-4 were filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

### *Drawings*

The drawings submitted on 4-1-4 overcome the previously cited objections, which are herein withdrawn.

### *Specification*

The Abstract submitted on 4-26-4 complies with the 150 word requirement and is therefore acceptable. The previous objection to the Abstract is herein withdrawn.

### *Claim Objections*

Claims 34 and 35 have been amended to successfully overcome the previous objections.

### *Claim Rejections - 35 USC § 101*

In view of the amendment of 4-26-04 and the remarks made on pages 23-24 respectively,

it is the Examiner's understanding that claims 15-17, 19 and 20 are directed to apparatus claims,

while claims 34-37 are directed to method claims.

### *Claim Rejections - 35 USC § 112*

The rejections of claims 15-20 and 34 based on 35 U.S.C. 112, second paragraph, are

herein withdrawn in view of the amendment filed 4-24-04 and the Examiner's understanding that

claims 15-17, 19 and 20 are directed to apparatus claims.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 16, 17, 20, 34, 36 and 37 rejected under 35 U.S.C. 102(b) as being anticipated

by the Ausubel patent (US 5,905,975).

The Ausubel reference discloses a trading system (and its associated method) for trading

forwards between parties, comprising:

A plurality of user stations, each including at least one display device and at least one input device, and a computer capable of executing forwards trades, the computer and the plurality of user stations communicating over a communications network, the trading system comprising programming executable in at least one of the computer and one or more user stations that provides for the trading system to:

display forwards for trading orders on display devices of user stations (col. 3, lines 1-30), and

execute trades of matched forwards trading orders of parties of counterparty pairs (col. 3, lines 30-67),

the programming also providing for a first counterparty of at least one counterparty pair to sequentially select for execution by the trading system, using the at least one display device and the at least one input device of a user station of the first counterparty (col. 11, line 15 through col. 12, line 38 and col. 2, lines 10-15), a series of forwards trading orders at least one second counterparty of the at least one counterparty pair displayed on the at least one display device of the user station of the first counterpary, with the trading system not executing any trade of matched forwards trading orders of the series until after all orders in the series are selected (col. 11, line 15 through col. 12, line 38) (claims 15 and 34).

The Ausubel reference discloses a trading system (and its associated method) for trading forwards between parties, comprising:

A plurality of user stations, each including at least one display device and at least one input device, and a computer capable of executing forwards trades, the computer and the

plurality of user stations communicating over a communications network, the trading system

comprising programming executable in at least one of the computer and one or more user

stations that provides for the trading system to:

display forwards for trading orders on display devices of user stations (col. 3, lines 1-30),

and

execute trades of matched forwards trading orders of parties of counterparty pairs (col. 3,

lines 30-67),

the programming also providing for, after execution of the trade, notification to the

parties of the counterparty pair displayed on display devices of the respective user stations of the

parties of the counterparty pair of the availability of a new forwards trade having the same

pricing and size terms as the executed trade (col. 1, lines 20-35), and

executing the new trade in response to input by both of the parties of the counterparty

pair at respective user stations using an input device to select the respective notification

displayed on a respective display device within a predetermined time after the parties of the

counterpart are provided with notification of the availability of the new trade (col. 3, lines 1-67)

(claims 16 and 36);

the programming provides a selectable area of the at least one display device of each of

the parties of the counterparty pair for notifying of the availability of the new trade, selection of

which by the parities of the counterparty pair using a respective input device causes the

programming to execute the new trade (col. 3, lines 1-30) (claim 17).

The Ausubel reference discloses a trading system (and its associated method) for trading forwards between parties, comprising:

A plurality of user stations, each including at least one display device and a computer capable of executing forwards trades, the computer and the plurality of user stations communicating over a communications network, the trading system comprising programming executable in at least one of the computer and one or more user stations that provides for the trading system to:

display selectable forwards trading orders of the plurality of parties on display devices of user stations (col. 3, lines 1-30), and

provide a function, selectable at user stations, for a party to add a new forwards trading order to the trading system, having pricing and size terms the same as an existing forwards trading order of another party(col. 1, lines 20-35), and

in response to selection of the function at a user station of one party and selection of an existing forwards trading order of another party displayed on a display device of the user station of the one party, automatically adding as a new forwards trading order to that user station of the one party, automatically adding as a new forwards trading order to that user station of the one party a forwards trading order having the same pricing and size terms as the selected forwards trading order of the other party (col. 11, line 15 through col. 12, line 38) (claims 20 and 37).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 19 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Ausubel patent in view of the Wilton et al. patent (US 6,519,574 B1).

The Ausubel reference discloses a trading system (and its associated method) for trading forwards between parties, comprising:

A plurality of user stations, each including at least one display device, and a computer capable of executing forwards trades, the computer and the plurality of user stations communicating over a communications network, the trading system comprising memory and programming executable in at least one of the computer and one or more user stations that provides for the trading system to:

Receive, process and store forwards orders and to execute trading forwards including a forwards spread trade comprising a first leg forwards trade and a second leg forwards trade, the difference between prices of the first and second leg forwards trades representing a price spread of the spread trade (col. 3, lines 1-67);

In connection with the processing and execution of a forwards spread trade, the programming providing for the trading system to:

Automatically generate from forwards orders stored in memory one of a forwards spread order including a spread price representing a difference between prices of potential first and second leg forwards trades and an order relating to one of the first and second leg forwards trades and a forwards spread order (col. 11, line 15 through col. 12, line 38),

display on display devices of user stations the automatically-generated order (col. 3, lines 1-30), and

in response to a request entered by a party at a user station to execute the automatically-generated order, execute the forwards spread trade including executing among the party and two other parties the first leg forwards trade at the first price and the second leg forwards trade at the second price, wherein the difference between the first and second prices represents the spread price of the spread trade (col. 11, line 15 through col. 12, line 38) (claims 19 and 35).

The Ausubel patent lacks a forwards spread trade wherein the spread is the difference between the prices of the first and second leg forwards trades.

The Wilton et al. patent teaches a forwards spread trade wherein the spread is the difference between the prices of the first and second leg forwards trades (Wilton, col. 3, lines 55-65 and col. 10, line 7 through col. 11, line 24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Ausubel patent with the teachings of the Wilton patent so as to provide the counterparties with the opportunity to maximize their transactions and customize them to take advantage of various changes in the market.

### *Response to Arguments*

With regard to claims 15 and 34, the Applicant contends that the Ausubel system does not allow a party to sequentially select orders at different prices. (page 27, amendment of 4-46-04). The Examiner disagrees. In Ausubel, the parties are capable of entering their bides either all at once, by inserting bidding rules, or they may constantly monitor the auction's progress and

enter all of his bids in real time. By allowing the user to enter their bids in real time, as a
response to monitoring the auction's progress, this essentially allows the user to sequential select
orders at different prices.

With regard to claims 16, 17 and 36, the Applicant asserts that the Ausubel system does
not disclose, after a trade is executed, (a) notification to the parties and (b) the system executing
a new trade in response to input by both parites to the executed trade within a predetermined
time after the parties are notified of the availability of the new trade (page 29, amendment of 4-
26-04). The Examiner disagrees. Ausubel does notify the parties and allows for execution of
new trades in response to input as disclosed in the discussion of ascending bid auction types in
col. 1, lines 20-35.

With regard to claims 19 and 35, the Applicant argues the Wilton reference (as per the
obviousness rejection based on 35 U.S.C. 103(a)) does not teach a trading system that
automatically generates a forwards spread order, nor does it execute the forwards spread trade in
response to a request entered by a party to execute the automatically-generated order. (page 35,
amendment of 4-26-4). The Examiner respectfully disagrees and understands Wilton as teaching
automatically generating spread orders (col. 2, lines 51-56) and also executing spread trades in
response to a request entered by a party (col. 7, lines 54-65).

With regard to claims 20 ad 37, the Applicant takes the position that the Ausubel system
does not disclose (a) a function for one party to add a new forwards trading order to the trading

system having pricing and sizing terms the same as an existing forwards order of another party,

and (b) which automatically adds a forwards trading order in response to the selection of the

function or that one bidder may enter the same response or part thereof of another bidder by

selecting the other bidders response (pages 31-32, amendment of 4-26-04). The Examiner

interprets Ausubel as having a function for one party to add a new forwards trading order having

pricing and sizing terms the same as an existing order because Ausubel states, "each bidder is

able to infer other bidders' information about the value of the object(s) as the auction progresses

and incorporate this information into his subsequent bids." As such, the bidders in Ausubel are

capable of learning the other's offers and incorporate that into their own subsequent bid, which is

what is presently claimed. Also, Ausubel also allows for automatically allowing orders to be

added by using the rules system described.

### Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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